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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,681	01/10/2002	Ernst Markart	3597-13-1	9212

7590 08/04/2005

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EXAMINER	
HYUN, PAUL SANG HWA	
ART UNIT	**PAPER NUMBER**
1743	

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/043,681	MARKART, ERNST	
	Examiner	Art Unit	
	Paul S. Hyun	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/10/2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-17,19,20,22 and 23* is/are pending in the application.

4a) Of the above claim(s) *22 and 23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-17,19,20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 11-17, 19, 20, 22 & 23 are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04/04/2002* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/10/02, 6/26/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 11-17, 19 and 20, drawn to a test strip kit for measuring the optical properties of a sample, classified in class 422, subclass 82.05.

II. Claims 22 and 23, drawn to a test strip kit for measuring the electrical properties of a sample, classified in class 422, subclass 82.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention I measures the optical properties of a sample, which performs a separate utility than Invention II, which measures the electrical properties of a sample. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with John C. Linderman on 7/26/05, a provisional election was made with the preservation of traverse to prosecute the

invention of Group I, claims 11-17, 19 and 20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22 and 23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

The disclosure is objected to because of the following informalities:

Examiner believes that Applicant intended the word "to" to be "the" in line 17 of page 1 of the Specification.

The reference "housing lower portion 12" should be referenced as "housing lower portion 14" in line 30 of page 5 of the Specification.

The reference "housing upper portion 14" should be referenced as "housing upper portion 12" in line 31 of page 5 of the Specification.

The reference "housing 10,12" should be referenced as "housing 12,14" in line 36 of page 5 of the Specification.

The reference "support surface 28" should be referenced as "support surface 26" in line 10 of page 6 of the Specification.

The reference "strip receiver 26" should be referenced as "strip receiver 16" in line 31 of page 6 of the Specification.

Examiner believes that Applicant intended the reference "nose 42" to be referenced as "nose 52" in line 8 of page 7 of the Specification.

Referring to lines 20-23 of page 7 of the Specification, Applicant is claiming reference 48 of Fig. 13 to be both "the clamping arm" and "a groove-shaped recess". It is not clear what reference 48 is.

Referring to lines 20-23 of page 7 of the Specification, Applicant is claiming the reference "a groove-shaped recess" to be both "47" and "48". It is not clear what reference number "a grove-shaped recess" is.

The reference "holding bar 18" should be referenced as "holding bar 88" in line 12 of page 9 of the Specification.

The reference "contact springs 20" should be referenced as "contact springs 100" in line 11 of page 10 of the Specification.

Appropriate corrections are required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference sign 98 is not included in Fig. 10 as disclosed by Applicant in line 18 of page 9 of the Specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the

changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 20 is objected to because of the following informalities:

The word "claming" in line 2 of the claim is misspelled.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hönes et al. (U.S. Patent 5,424,035).

In reference to claim 11, Hönes et al. disclose a test strip analysis system comprising:

A test strip 4 with a test field 6; and

An analysis apparatus 2 for measuring the test field that includes a test strip holder 3, wherein the test strip holder 3 has a support surface for the test

strip as well as a positioning means in the form of a retaining lug 26 that engages the test strip in a definite position relative to the support surface. The apparatus 2 further comprises two holding means 39 spaced from one another on the edges of the support surface for holding the edges of the test strip. In addition, the middle area 20 of the support surface is vertically displaced from the edges of the support surface (see Figs. 1 & 2).

In reference to claim 12, the middle area 20 of the support surface of apparatus 2 has a projection supporting the test field 6 of the test strip (see Fig. 2).

Claims 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Markart et al. (U.S. Patent 5,281,395).

In reference to claim 13, Markart et al. disclose a test strip analysis system comprising a test strip 2 with a test field 5 and a measuring device 1 for measuring the test field. The measuring device 1 includes a strip receiver 7 having a support surface 20a where the strip lies when it is inserted into the measuring device. The test strip is held in a definite position within the measuring device relative to the support surface by the interaction of recess 26 of the test strip and a catching element 24 of the measuring device. Fig. 4 of the reference shows that the strip receiver 7 has an outer insertion end and an inner end and that the inner end includes the catching element, which is spring biased (see line 5 col. 6). The catching element rises from the support surface toward the inner end of the strip receiver in order to accommodate the test strip and it elastically

deflects in the direction toward the support surface to lock the strip in its place. A counter-pressure surface 33 is associated with the catching element and it extends upwardly and rearwardly from the support surface toward the inner end of the strip receiver eventually extending parallel to the catching element.

In reference to claim 14, the catching element 24 further includes a catching projection 25 that interacts with recess 26 of the test strip (see Fig. 4 and lines 22-23 col. 5).

Claims 15-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Meinecke et al. (U.S. Patent 4,780,283).

Meinecke et al. disclose a test strip analysis apparatus comprising:

A test strip 22 with a test field 60; and

A measuring device for measuring the test field (see Figs. 1 & 2). The measuring device has a strip receiver 2, which includes a support surface 24 for the test strip. The measuring device utilizes a pivotal clamping lever mechanism comprising a cam plate 26 and a clamping arm in the form of a stop pin 28 that is biased towards and situated parallel to the surface of the test strip 22 to hold the test strip in place. The stop pin 28 penetrates a recess 52 of test strip 22 to lock the test strip in its place within the apparatus (see lines 63-66 col. 8). The cam plate 26 of pivotal clamping lever mechanism acts as a second lever arm against which a spring 30 works and biases the stop pin 28 toward the surface of the test strip.

In reference to a groove that guides the test strip, the reference further discloses a guide element 32 that interacts with a guide slot 34. It appears that the guide element and the guide slot interact by means of a groove, which narrows conically in the direction of insertion and brings the test strip in position that allows stop pin 28 to penetrate recess 52 of the test strip (see line 64 col. 3 – line 8 col. 4). Moreover, the guiding element is formed in the region of the stop pin 28, which acts as a clamping arm (see lines 59-66 col. 8).

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 5/20/1998. It is noted, however, that applicant has not filed a certified copy of the 198 22 770.1 application as required by 35 U.S.C. 119(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul S. Hyun whose telephone number is (571)-272-8559. The examiner can normally be reached on Monday-Friday 8AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PSH 7/26/05

Jill Warden
Supervisory Patent Examiner
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